UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,607	06/09/1999	SWARUP ACHARYA	ACHARYA3-6-8	7017

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EXAMINER
SINGH, RACHNA

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 12/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 October 2003</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-24 and 28-35* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1,3-24 and 28-35* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.
13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
    since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
    37 CFR 1.78.
    a) ☐ The translation of the foreign language provisional application has been received.
14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
    reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1.   This action is responsive to communications: Request for Continued

Examination filed 10/1/03 and Amendment C filed 10/1/03.

2.   Claims 1, 3-24, and 28-35 are pending in the case. Claims 1, 17, 21, 28, 30, and

33 are independent claims.

Continued Examination Under 37 CFR 1.114

3.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/1/03

has been entered.

Priority

4.   Acknowledgment is made of a claim for domestic priority.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1, 3-7, and 15-16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Kenner et al., US Patent 6,112,239, 8/29/00 (filed 6/18/97).

In reference to claim 1, Kenner teaches a system and method for optimizing data delivery on a distributed computer network. The system comprises the following: -Providing a link to a file (i.e. video clip, advertising banner) to a user browsing web pages. The file is managed by a service provider's delivery system which maps the user's IP address to a look-up table to determine which sites are "electronically close" to the user. See column 5, lines 5-51 and column 6, lines 16-30. Compare to ***"displaying, at the client computer, a multilink as a hyperlink, the multilink providing a logical point of access to a plurality of files, each of the plurality of files having a respective unique electronic address, each of the electronic addresses being contained in a file at the client computer, the file being interpretable to display the multilink;"*** -Providing the user with either a single delivery site or list of delivery site addresses for the servers. The user terminal can then serve as a router making the final delivery site selection. See figure 4 and column 6, lines 16-30. Compare to ***"generating a menu of options, at the client computer, in response to user's selection of the multilink, each option of the menu of options being associated with at least one of the plurality of files. . .transmitting, from the client computer, a request for a user-selected file associated with the user-selected option, the request being made using a corresponding one of the electronic addresses on file"***.

Although Kenner does not state that the file is at the client computer, he does teach that the file is delivered to the client program, thus it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the file interpretable

to display the multilink at the client computer as it allows the client to view the electronic

addresses available to the user.

In reference to claim 3, Kenner teaches that the user selects one of the

addresses from the list of options before the file is transmitted. See column 6, lines 16-

30.

In reference to claim 4, Kenner teaches that the user's selection points to a

delivery address. See column 6, lines 16-30.

In reference to claim 5, Kenner teaches that files are associated with a plurality of

addresses associated with that file. See columns 5-6.

In reference to claims 6 and 7, Kenner teaches that a "look-up table" that

correlates the addresses with the file are identified in order to present a list of options to

the user. See column 6, lines 5-30.

In reference to claim 15, Kenner teaches that the list of options are Internet

addresses (URLs). See column 6, lines 5-50.

In reference to claim 16, Kenner teaches that the original link is a multilink that is

then associated with a plurality of files. See columns 5-6.

7.   Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kenner et al., US Patent 6,112,239, 8/29/00 (filed 6/18/97) in view of Airth, "Navigation

in Pop-up Menus", pages 115-116, 1993.

In reference to claim 8, Kenner generates a list of options from which a user can

select a site; however, the menu of options is not presented in a pop-up display. Airth

teaches that navigational pop-up menus were well known in the art at the time of the

invention. See page 115. It would have been obvious to one of ordinary skill in the art

to present Kenner's menu of options as a pop-up display since pop-up-menus allow the

menu area to be more accessible to the user as it appears over objects currently

displayed.

In reference to claims 9 and 10, Kenner teaches that a single delivery site

address that presents the single site that contains the delivery system program. See

column 6.

8.   Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kenner et al., US Patent 6,112,239, 8/29/00 (filed 6/18/97) in view of Airth, "Navigation

in Pop-up Menus", pages 115-116, 1993, as applied to claim 10 above, and further in

view of Foley et al., US Patent 5,706,502, 1/6/98.

In reference to claims 11 and 12, it was well known in the art at the time of the

invention to utilize proxy computers within a network as a method of increasing

performance. Thus transmitting a file containing a multilink URL to a proxy computer

would have been obvious to one of ordinary skill in the art in order to save time and

expedite requests for a multilink URL that identifies a plurality of files. Kenner does not

teach appending a computer program to the file; however, Foley teaches a portfolio file

including references to a set of project files. These project files can be local to the first

computer or to a web page URL. Foley also teaches organizing executable programs

into these portfolios. Foley's invention discloses that it was well known in the art a the

time of the invention to import certain software programs to a file. See columns 2-4.

Thus it would have been obvious to one of ordinary skill in the art at the time of the

invention to append the computer program to the file as taught by Foley to the system of

generating a list of files as taught by Kenner since it allows a user to carry out various

functions using program code such as a list generation.

In reference to claims 13 and 14, Foley teaches transmitting the file to the first

computer (client computer). See columns 2-3. The rest of claims 13 and 14 are

rejected under the rationale used above in reference to claims 11 and 12.

9.   Claims 17-24 and 28-35 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Kenner et al., US Patent 6,112,239, 8/29/00 (filed 6/18/97) in view of

Foley et al., US Patent 5,706,502, 1/6/98.

In reference to claims 17, 21, 28, and 30, Kenner teaches a system and method

for optimizing data delivery on a distributed computer network. The system comprises

the following:

-Providing a link to a file (i.e. video clip, advertising banner) to a user browsing web

pages. The file is managed by a service provider's delivery system which maps the

user's IP address to a look-up table to determine which sites are "electronically close" to

the user. See column 5, lines 5-51 and column 6, lines 16-30. Compare to

"displaying, at the client computer, a multilink as a hyperlink, the multilink

providing a logical point of access to a plurality of files, each of the plurality of

files having a respective unique electronic address, each of the electronic

addresses being contained in a file at the client computer, the file being

interpretable to display the multilink;"

-Providing the user with either a single delivery site or list of delivery site addresses for

the servers. The user terminal can then serve as a router making the final delivery site

selection. See figure 4 and column 6, lines 16-30. Compare to *"generating a menu of*

options, at the client computer, in response to user's selection of the multilink,

each option of the menu of options being associated with at least one of the

plurality of files. . .transmitting, from the client computer, a request for a user-

selected file associated with the user-selected option, the request being made

using a corresponding one of the electronic addresses on file".

Although Kenner does not state that the file is at the client computer, he does

teach that the file is delivered to the client program, thus it would have been obvious to

one of ordinary skill in the art at the time of the invention to provide the file interpretable

to display the multilink at the client computer as it allows the client to view the electronic

addresses available to the user.

Kenner does not teach appending the first computer program to a file transmitted

by the servicing computer; however, Foley teaches a portfolio file including references

to a set of project files. These project files can be local to the first computer or to a web

page URL. Foley also teaches organizing executable programs into these portfolios.

Foley's invention discloses that it was well known in the art at the time of the invention

to import certain software programs to a file. See columns 2-4. Thus it would have

been obvious to one of ordinary skill in the art at the time of the invention to append the

computer program to another computer program as taught by Foley to the system of

generating a directory of files as taught by Kenner since Foley's system allows a user to

carry out various functions using program code such as the claimed generation of a menu.

In reference to claims 18 and 22, Foley's computer is implemented in a network environment which consists of a server. Thus assembling the programs from the components of various Internet nodes would be done on a server computer. See columns 1-4.

In reference to claims 19 and 23, it is well known in the art to utilize a proxy computer to expedite the request between a client and server computer thus using a proxy computer for relaying the communication would have been obvious to one of ordinary skill in the art at the time of the invention.

In reference to claims 20, 24, 29, and 31, Foley teaches a method in which the user can import certain software programs for execution with a file. It would have been obvious to one of ordinary skill in the art at the time of the invention to append the computer program to certain types of files such as those containing multilink URLs since the user can specify which files should have the computer program appended to them.

In reference to claim 32, Kenner discloses a network server computer for accessing files and providing program execution to the individual computers. See columns 5-6.

Claims 33-35 are rejected under the same rationale as claims 1, 5, and 7 respectively above.

Response to Arguments

10.   Applicant's arguments with respect to claims 1, 3-24, and 28-35 have been

considered but are moot in view of the new ground(s) of rejection.

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

US Patent 6,035,330   Astiz et al.

US Patent 6,408,296   Acharya et al.

US Patent 5,867,162   O'Leary et al.

US Patent 6,230,196   Guenthner et al.

US Patent 6,085,199   Rose et al.

US Patent 6,208,995   Himmel et al.

12.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Rachna Singh whose telephone number is

703.305.1952. The examiner can normally be reached on M-F (8:30-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Feild can be reached on 703.305.9792. The fax phone number for

the organization where this application or proceeding is assigned is 703.872.9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is

703.305.3900.

RS
12/10/03

JOSEPH H. FEILD
PRIMARY EXAMINER